

#4

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): HOFFMAN, Ned

Serial No.: Not yet assigned

Examiner: Not yet assigned

Filing Date: Herewith

Group Art Unit: Not yet assigned

Title: **TOKENLESS IDENTIFICATION SYSTEM FOR AUTHORIZATION OF  
ELECTRONIC TRANSACTIONS AND ELECTRONIC TRANSMISSIONS**

jc979 U.S. PTO  
10/056982



Box DD  
ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Sir:

This Information Disclosure Statement is submitted:

- ☒ under 37 CFR 1.97 (b), or  
(Within three months of filing national application; or date of entry of International application;  
or before mailing date of first office action on the merits; whichever occurs last)
- ☐ under 37 CFR 1.97 (c) together with either a:  
☐ Statement under 37 CFR 1.97 (e), or  
☐ a \$180 fee under 37 CFR 1.17 (p), or  
(After mailing of first Office Action, but prior to Notice of Allowance or Final Office Action)
- ☐ under 37 CFR 1.97 (d) together with:  
☐ Statement under 37 CFR 1.97 (e),  
☐ Applicant hereby petitions for the consideration of the accompanying information  
disclosure statement (37 C.F.R. §1.97(d)(ii).  
☐ a \$130.00 petition fee set forth in 37 CFR 1.17 (i)(1).  
(Filed after final action or notice of allowance, whichever occurs first, but before payment of

the issue fee)

☒ Applicant(s) submit herewith Form PTO 1449- Information Disclosure Citation together with  
copies of patents, publications or other information of which applicant(s) are aware, which applicant(s) believe(s)  
may be material to the examination of this application and for which there may be a duty to disclose in accordance  
with 37 CFR 1.56.

It is requested that the information disclosed herein be made of record in this application.

The references listed on the attached Form PTO 1449- Information Disclosure Citation are submitted for  
the Examiner's reference only and are not prior art to the enclosed patent application.

Any deficiency or overpayment should be charged or credited to deposit account number 13-1703. A  
duplicate copy of this sheet is enclosed.



20575

PATENT TRADEMARK OFFICE

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

MARGER JOHNSON & McCOLLOM, P.C.  
1030 SW Morrison Street  
Portland, OR 97205  
503-222-3613

Ariel Rogson  
Reg. No. 43,054

# PATENT APPLICATION

Atty. Docket No.: 8514-75  
 Applicant: Hoffman, Ned  
 Filing Date: Herewith

Serial No. Not yet assigned  
 Group: Not yet assigned

## INFORMATION DISCLOSURE CITATION FORM PTO-1449 (Modified)

10/05/98  
 01/23/02

### U.S. PATENT DOCUMENTS

| <u>Exam</u><br><u>Init</u> | <u>Ref</u> | <u>Document</u><br><u>Number</u> | <u>Issue</u><br><u>Date</u> | <u>Name</u>      | <u>Class</u> | <u>Sub-</u><br><u>Class</u> |
|----------------------------|------------|----------------------------------|-----------------------------|------------------|--------------|-----------------------------|
| _____                      | _____      | 2001/0000045                     | Mar. 15, 2001               | Yu et al.        | 707          | 9                           |
| _____                      | _____      | 6,182,076                        | Jan. 30, 2001               | Yu et al.        | 707          | 10                          |
| _____                      | _____      | 6,012,039                        | Jan. 2000                   | Hoffman et al.   | 705          | 14                          |
| _____                      | _____      | 5,930,804                        | Jul. 27, 1999               | Yu et al.        | 707          | 104                         |
| _____                      | _____      | 5,870,723                        | Feb. 1999                   | Pare, Jr. et al. | 705          | 39                          |
| _____                      | _____      | 5,615,277                        | Mar. 1997                   | Hoffman          | 382          | 115                         |
| _____                      | _____      | 5,613,012                        | Mar. 1997                   | Hoffman et al.   | 382          | 115                         |

### FOREIGN PATENT DOCUMENTS

| <u>Document</u><br><u>Number</u> | <u>Publication</u><br><u>Date</u> | <u>Country</u> | <u>Name</u> |
|----------------------------------|-----------------------------------|----------------|-------------|
| _____                            | _____                             | _____          | _____       |
| _____                            | _____                             | _____          | _____       |
| _____                            | _____                             | _____          | _____       |

### OTHER DOCUMENTS

| <u>Exam</u><br><u>Init</u> | <u>Ref</u> | <u>(Including Author, Title, Date, Pertinent Pages, etc.)</u> |
|----------------------------|------------|---|
| _____                      | _____      | _____   |
| _____                      | _____      | _____   |
| _____                      | _____      | _____   |

Examiner: \_\_\_\_\_

Date Considered: \_\_\_\_\_

**Information Disclosure Statement**

This application is a continuation-in-part of U.S. Patent Application Serial No. 09/639,948 filed on August 17, 2000, now pending, which is a continuation-in-part of U.S. Patent Application Serial No. 09/398,914 filed September 16, 1999, now pending, which is a continuation-in-part of U.S. Patent Application Serial No. 09/244,784 filed February 5, 1999, now U.S. Patent No. 6,012,039, which is a continuation-in-part of U.S. Patent Application Serial No. 08/705,399, filed August 29, 1996, now U.S. Patent No. 5,870,723, which is a continuation-in-part of U.S. Patent Application Serial No. 08/442,895 filed May 17, 1995, now U.S. Patent No. 5,613,012, which is a continuation-in-part of U.S. Patent Application Serial No. 08/345,523, filed November 28, 1994, now U.S. Patent No. 5,615,277, all of which are commonly assigned and incorporated herein by reference.

The subject matter of the specification supporting the claims in this patent application can be traced at least as far back as U.S. Patent Application Serial No. 08/442,895 filed May 17, 1995, now U.S. Patent No. 5,613,012. Page 1, line 20 through page 9, line 4 finds support in the '012 patent at column 1, line 15 through column 6, line 4. Page 9, line 7 through page 147, line 27 finds support in the '012 patent at column 6, line 8 through column 93, line 51. Page 1, line 20 through page 9, line 4 also finds support, for example, in U.S. Patent Application Serial No. 09/398,914 filed September 16, 1999, now pending, at page 1, line 27 through page 10, line 17.

The claims presented in this patent application are supported by all of the patent applications listed above, at least as far back as U.S. Patent Application Serial No. 08/442,895 filed May 17, 1995, now U.S. Patent No. 5,613,012.

Claims 49 and 50 presented in this patent application are substantially copied from and interfere with claims 1 and 5 of U.S. Patent Application Publication US 2001/0000045, Serial No. 09/728,052, filed by Yu et al. and shown on the face of the published patent application to have a correspondence address care of U.S. Philips Corporation. Except for language choices for certain terms (discussed below), claims 49 and 50 of the present patent application are identical to claims 1 and 5 of Yu et al. Support for claims 49-50 of the present patent application can be found in the present specification (as well as the parent patents and applications) at the following locations, among others:

Page 14, line 21 through page 15, line 2;



Page 20, lines 26-28;  
Page 45, lines 24-25;  
Page 47, lines 5-8 and 12-15;  
Page 49, line 21 through page 55, line 11;  
Page 54, line 25;  
Page 56, line 20;  
Page 66, line 19;  
Page 71, lines 19-23;  
Page 73, lines 32-33;  
Page 98, lines 21-23, 26, and 33;  
Page 100, lines 9-13;  
Page 107, lines 8-9 and 22-23;  
Page 133, lines 3-6, 11-14, and 24-27;  
Page 141, line 30 through page 141, line 2;  
Page 143, lines 9-16 and 29-31; and  
FIGs. 1-4.

Corresponding disclosure in U.S. Patent No. 5,613,012 can be found at the following locations, among others:

Column 13, lines 17-20;  
Column 27, lines 8-10 and 63-67;  
Column 68, lines 5-9;  
Column 29, line 24 through column 32, line 25;  
Column 32, lines 38-39;  
Column 33, lines 38-39;  
Column 39, lines 35-37;  
Column 42, lines 25-29;  
Column 43, lines 57-59;  
Column 57, lines 17-20;  
Column 61, lines 46-47 and 65-66;  
Column 75, lines 34-36 and 56-60;  
Column 78, line 26 through column 84, line 53; and  
FIG. 1.

Because of naming variations between the Yu patent application and the present patent application, some terms have been changed but mean or encompass the same things.

The Yu patent application describes the system and method of the inventions as using a “Web cloud.” This limits the communications between the components of the Yu patent application to communications via the Web. The specification of the present application describes “interconnecting means” as being used for communications between components of the invention, and specifically, the use of the Internet for communications. It is well known that the Web is a subset of the Internet. Accordingly, the use of the Internet in claims 49 and 50 is broader than the “Web cloud” limitation of claims 1 and 5 of the Yu patent application, and therefore encompasses the Yu limitation.

The Yu patent application discusses the use of a “Web client.” The “Web client” is nothing more than a device for collecting the biometric for use in identifying and/or authenticating a user. As such, the “gathering means” of claims 49 and 50 encompasses the “Web client” limitation of claims 1 and 5 of the Yu patent application.

The Yu patent application discusses the use of a “Web server.” The “Web server” is a device to which the individual seeks access via the biometric. As such, the “computer network” of claims 49 and 50 encompasses the “Web server” limitation of claims 1 and 5 of the Yu patent application.

The Yu patent application discusses the use of an “authentication center.” The “authentication center” authenticates an individual based on his/her biometrics. In the present specification, that function is performed by the “data processing center.” Accordingly, the “data processing center” of claims 49 and 50 of the present application is similar to the “authentication center” of claims 1 and 5 of the Yu patent application. (The Examiner may note that the “data processing center,” as described in the present patent application, can perform other functions beyond authentication, although the data processing center is expressly associated with authentication in claims 49 and 50.)

The Yu patent application discusses the use of “live data.” The “live data” is a very narrow category of data. In contrast, the “real time data” of claims 49 and 50 is a broad category of data, and include (among others) the “live data” of the Yu patent application. As such, the “real time data” of claims 49 and 50 is broader than the “live data” limitation of claims 1 and 5 of the Yu patent application, and therefore encompasses the Yu limitation.

Copies of Forms PTO-1449 and 892 are enclosed from these six prior applications from which priority is claimed. It is understood that the listed references from Applicant’s prior applications will be considered in the examination of the application and that no separate copies of the same prior art are required to be provided since they were previously

cited or transmitted in the foregoing prior application. 37 CFR Section 1.98(d). Form(s) PTO 1449 is enclosed listing references cited by the Examining Attorney and submitted by applicant in the prior applications. The list of references provided on Form PTO-1449 does not constitute an admission that the references are prior art under 35 U.S.C. § 102, as some of the references are dated after Applicant's priority date.

Enclosed herewith to assist the Examiner are copies of all of Applicant's patents from which this case claims priority under 35 U.S.C. § 120.

Also enclosed are copies of U.S. Patent No. 6,182,076 issued on January 30, 2001 to Yu et al., U.S. Patent No. 5,930,804 issued on July 27, 1999 to Yu et al., and U.S. Patent Application Publication No. US 2001/0000045, Serial No. 09/728,052. The filing dates of applicant's priority applications (now issued patents 5,613,012, filing date May 17, 1995, and 5,615,277, filing date November 28, 1994) predate Yu '804, which was filed June 9, 1997. The filing dates of applicant's priority applications also predate Yu '076, which was filed on Dec. 9, 1998 and claimed priority from Yu '804. The filing dates of applicant's priority applications also predate Yu '0000045, which was filed December 1, 2000 and claimed priority from Yu '076 and Yu '804. Therefore, Yu '804, Yu '076, and Yu '0000045 should not be considered as prior art references to applicant's continuation application and are not included on the enclosed form PTO-1449.

Form PTO-1449 (modified)  
INFORMATION DISCLOSURE CITATION

Atty. Docket No.  
8514-75

Serial No.

Applicant:  
Hoffman

Filing Date

Group

### U.S. PATENT DOCUMENTS

| Initial | Document Number | Date    | Name            | Class | Subclass |
|---------|-----------------|---------|-----------------|-------|----------|
| ___     | 4,321,672       | 3/1982  | Braun           | 364   | 408      |
| ___     | 4,390,968       | 6/1983  | Hennessy        | 364   | 900      |
| ___     | 4,484,328       | 11/1984 | Schlaflly       | 370   | 394      |
| ___     | 4,675,815       | 6/1987  | Kuroki          | 364   | 900      |
| ___     | 4,734,858       | 3/1988  | Schlaflly       | 705   | 26       |
| ___     | 4,799,156       | 1/1989  | Shavit          | 364   | 401      |
| ___     | 4,821,118       | 4/1989  | Lafreniere      | 358   | 108      |
| ___     | 4,837,422       | 6/1989  | Dethloff et al. | 364   | 408      |
| ___     | 4,926,480       | 5/1990  | Chaum           | 380   | 23       |
| ___     | 4,947,028       | 8/1990  | Gorog           | 235   | 380      |
| ___     | 4,961,142       | 10/1990 | Elliott et al.  | 364   | 408      |
| ___     | 4,993,068       | 2/1991  | Piosenka et al. | 380   | 23       |
| ___     | 4,995,086       | 2/1991  | Lilley et al.   | 382   | 4        |
| ___     | 4,998,279       | 3/1991  | Weiss           | 340   | 825      |
| ___     | 5,036,461       | 7/1991  | Elliot et al.   | 364   | 408      |
| ___     | 5,054,089       | 10/1991 | Uchida et al.   | 382   | 4        |
| ___     | 5,095,194       | 3/1992  | Barbanell       | 235   | 380      |
| ___     | 5,109,427       | 4/1992  | Yang            | 382   | 4        |
| ___     | 5,109,428       | 4/1992  | Igaki et al.    | 382   | 5        |
| ___     | 5,144,680       | 9/1992  | Kobayashi       | 250   | 556      |
| ___     | 5,145,102       | 9/1992  | Higuchi et al.  | 382   | 4        |
| ___     | 5,146,102       | 9/1992  | Higuchi et al.  | 250   | 556      |
| ___     | 5,168,520       | 12/1992 | Weiss           | 380   | 23       |
| ___     | 5,180,901       | 1/1993  | Hiramatsu       | 235   | 380      |
| ___     | 5,191,611       | 3/1993  | Lang            | 380   | 25       |
| ___     | 5,210,588       | 5/1993  | Lee             | 356   | 71       |
| ___     | 5,210,797       | 5/1993  | Usui et al.     | 382   | 4        |
| ___     | 5,222,152       | 6/1993  | Fishbine et al. | 382   | 2        |
| ___     | 5,224,164       | 6/1993  | Eisner et al.   | 380   | 44       |
| ___     | 5,229,764       | 7/1993  | Matchett et al. | 340   | 825.34   |
| ___     | 5,230,025       | 7/1993  | Fishnine et al. | 382   | 4        |
| ___     | 5,239,583       | 8/1993  | Parrillo        | 380   | 23       |
| ___     | 5,241,606       | 8/1993  | Horie           | 382   | 4        |
| ___     | 5,251,259       | 10/1993 | Mosley          | 380   | 23       |
| ___     | 5,265,162       | 11/1993 | Bush et al.     | 380   | 24       |
| ___     | 5,276,314       | 1/1994  | Martino et al.  | 235   | 380      |
| ___     | 5,280,527       | 1/1994  | Gullman et al.  | 380   | 23       |
| ___     | 5,321,242       | 6/1994  | Heath, Jr.      | 235   | 382      |

Examiner

Date Considered

\*Examiner: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[illegible]

Examiner

Date Considered

\*Examiner: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



|                                 |                         |                   |
|---------------------------------|-------------------------|-------------------|
| <b>Form PTO-1449 (modified)</b> | <b>Atty. Docket No.</b> | <b>Serial No.</b> |
| INFORMATION DISCLOSURE CITATION | 8514-75                 |                   |
| <b>Applicant:</b><br>Hoffman    |                         |                   |
| <b>Filing Date</b>              | <b>Group</b>            |                   |

### FOREIGN PATENT DOCUMENTS

| Initial | Document Number | Date      | Country | Name                               | Class | Subclass |
|---------|-----------------|-----------|---------|------------------------------------|-------|----------|
| _____   | WO/95/13591     | 5/18/1995 |         | Jasper Consulting, Inc.            |       |          |
| _____   | WO/98/25227     | 6/11/1998 |         | Dew Engineering and<br>Development |       |          |
| _____   | 0651357A1       | 3/5/1995  |         | Holloway                           |       |          |
| _____   | 0581421A1       | 2/2/1994  |         | Gajnak                             |       |          |
| _____   | EP0823701A2     | 2/1998    |         | Fromm                              |       |          |
| _____   | WO98/50875      | 11/1998   |         | Delude et al.                      |       |          |
| _____   |                 |           |         |                                    |       |          |
| _____   |                 |           |         |                                    |       |          |
| _____   |                 |           |         |                                    |       |          |
| _____   |                 |           |         |                                    |       |          |

### OTHER DOCUMENTS

(including author, title, source, date, pertinent pages)

- \_\_\_\_\_ Anderson et al., *Security Management*, American Society for Industrial Security v.37, n.11, 17-19 (November 1993)
- \_\_\_\_\_ Radcliff, *When Data Warehouse become Open House*, Software Management, v.16 n.11 (November 26, 1996).
- \_\_\_\_\_ Anonymous, *A Credit Union Points a Finger at Biometrics*, Bank Network News, v.15 n.16 (January 13, 1997).
- \_\_\_\_\_ Hall, J., *Scanning Lets Fingerprints Do Talking*, Toronto Star, PA6 (May 15, 1997).
- \_\_\_\_\_ Scally, R., *CompUSA Tests Fingerprints to Help Secure Transactions*, Discount Store News, v.36 n.10 (May 19, 1997).

Examiner

Date Considered

\*Examiner: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.